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(For Applicant)

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(For Petitioner)

In re application of
Gary R. Tucholski et al.
Serial No.: 07/641,394
Filed: January 15, 1991
For: BATTERIES WITH TESTER LABEL

DECISION RE ACCESS

This is in response to a petition filed August 30, 1993, by Eastman Kodak Company entitled PETITION FOR ACCESS. Petitioner states that U.S. Patent No. 5,223,003 relies for priority, under 35 U.S.C. § 120, on the '394 application. Petitioner requests a copy of the portion of the '394 application that relates to the common subject matter of the '003 patent application including all materials relating to the prosecution in the application of the subject matter claimed in the '003 patent, or access to the complete application if applicant permits.

A review of the record shows the '003 patent is identified as a continuation-in-part of the '394 application. Accordingly, the '003 patent relies, under 35 U.S.C. § 120, upon the filing date of the '394 application with regard to common subject matter. The '394 application is currently pending. 37 CFR § 1.14(a).

Whenever a patent relies upon the filing date of an earlier but still pending application, the public is entitled to see the portion of the earlier application that relates to the common subject matter, and also what prosecution, if any, was had in the earlier application of subject matter claimed in the patent. MPEP 103.

On September 10, 1993, a letter was sent to applicant informing him of the petition for access and providing a three week period for applicant to object to the entire '394 application being made available. On September 23, 1993, applicant filed a paper objecting to the request for access of the entire application file.

A review of the record shows the claims of the '003 patent are drawn to a "process for preparing a label comprising a tester for a battery and for attaching it to a battery," while on the other hand all of the application claims are drawn to an apparatus, i.e., to a battery or to a label, except for claim 45, which recites a process for attaching a label to a battery. The examiner required restriction between claims 1 to 44 and claim 45, finding that they are drawn to distinct inventions.

Accordingly, it is not considered that the apparatus claims in the application constitute subject matter claimed in the patent within the meaning of MPEP § 103. The petition is granted only to the extent that petitioner is granted access to the prosecution relating to claim 45 of the application, viz., (1) the examiner's restriction requirement of January 9, 1992, (Paper No. 4); (2) applicant's response thereto filed January 17, 1992, (Paper No. 5); (3) the portions of the next Office action mailed March 27, 1992, (Paper No. 6) making the restriction requirement final, which are the first page, the first two paragraphs on page 2, and the last paragraph on page 3; and (4) parts of the amendment filed October 2, 1992, (Paper No. 7) consisting of page 4, the paragraph canceling claims 43-45, and page 5, the first paragraph under "Remarks."

The petition is granted to the extent indicated. A copy of the '394 application as filed (common subject matter), and the materials (1) to (4) above are enclosed.

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